

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

REIM-0001

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on August 4, 2006

Signature Karen Vertz

Typed or printed name Karen Vertz

Application Number

10/032,508

Filed

October 27, 2001

First Named Inventor

Senthil Kumar, et al.

Art Unit

2145

Examiner

Tanim M. Hossain

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 33,182
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

David H. Hitt

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(972) 480-8800

Date

August 3, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Senthil Kumar, *et al.*
Serial No.: 10/032,508
Confirmation No.: 3871
Filed: October 27, 2001
Title: MEDIA AND ADVERTISEMENT DISTRIBUTION AND TRACKING
SYSTEM AND METHOD OF OPERATION THEREOF
Grp./A.U.: 2145
Examiner: Hossain, Tanim M.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicants have carefully considered this Application in connection with the Examiner's Final Rejection mailed June 5, 2006, and respectfully request a pre-appeal brief review of this application in view of the following remarks.

REMARKS/ARGUMENTS

The present Application was filed on October 27, 2001. The Appellants filed a first Amendment on July 1, 2005 in response to a first Examiner's Action mailed January 26, 2005. The Examiner entered the first Amendment and subsequently issued a Final Rejection on September 20, 2005. The Appellants then filed a second Amendment on November 21, 2005. The Examiner indicated in an Advisory Action on December 20, 2005 that the second Amendment did not place the Application in condition for allowance, and declined to enter the second amendment. The Appellants then filed a first Notice of Appeal on January 20, 2006. The Examiner withdrew the finality of the previous final rejection, entered the amendments submitted November 21, and issued a new Final Rejection based on new grounds on June 5, 2006.

I. Rejection of Claims 1-20 under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-3, 7-10 and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Appl. No. 2002/0073084 to Kauffman, *et al.* in view of U.S. Patent Appl. No. 2003/0229893 to Sgaraglino; Claims 4 and 11 over Kauffman and Sgaraglino, in further view of U.S. Patent No. 6,256,554 to DiLorenzo; Claims 5 and 12 over Kauffman and Sgaraglino, in further view of U.S. Patent No. 6,144,944 to Kurtzman, II, *et al.* (Kurtzman); Claims 6 and 13 over Kauffman and Sgaraglino, in further view of U.S. Patent Appl. No. 2001/0044855 to Vermeire, *et al.*; Claim 15, 16, 17 over Kauffman and Sgaraglino, in further view of U.S. Patent Appl. No. 2002/0046279 to Chung; Claim 18 over Kauffman, Sgaraglino, and DiLorenzo, in further view of Chung; Claim 19 over Kauffman, Sgaraglino, and Kurtzman, in further view of Chung; and Claim 20 over Kauffman, Sgaraglino, and Vermeire, in further view of Chung. The

Applicants respectfully traverse the Examiner's rejection, because the various combinations cited by the Examiner fail to teach each and every element of the respective Claims.

Specifically, the cited combinations do not teach a "remote player." A remote player is "any type of hardware or software capable of playing the distributed media and advertising and returning as-run logs describing what they have played and when." (Specification, ¶ 29.) Kauffman does teach a caching inserter 30 that may be associated with a billing system 42 (See ¶ [0018].) However, Kauffman does not teach that caching inserter 30 has any display capability, so it is not a remote player.

Kauffman also teaches a television 12. (See ¶ [0009].) However, the television 12 is not a remote player because it not capable of returning as-run logs. (See *id.*) Kauffman explicitly makes this distinction by teaching that the caching inserter 30 is not located in the television 12. (See Fig. 1; ¶¶ [0009], [0018].) Instead, the caching inserter 30 is located on a signal path "*at the extreme*" in a set-top box 14. (See ¶¶ [0009], [0010], *emphasis added.*) Therefore, the television 12 cannot return as-run logs, and is not a remote player.

Kauffman also teaches a computer terminal 16 that may be used to receive multimedia information, but the computer terminal 16 is also not a remote player. One of ordinary skill in the art understands that a computer terminal is a device for entering data into and receiving data from a computer. Further, one skilled in the art understands that a computer terminal may include minimal programming necessary to implement terminal functions, but is not configurable in a general manner. Kauffman teaches that the computer terminal 16 may include software to convert received files and play them on a display. (See ¶ [0017].) But Kauffman is silent with respect to the computer terminal 16 being capable of returning as-run logs. Furthermore, because Kauffman

teaches explicitly that the caching inserter 30 could be located as far along a signal path as a set-top box 14, but *no further*, the reference as a whole teaches that the computer terminal 16 is not capable of returning as-run logs. Therefore, the computer terminal 16 cannot return as-run logs, and is not a remote player.

Furthermore, even if the computer terminal 16 by Kauffman is *capable* of returning as-run logs, while maintaining that it is not, Kauffman does not enable the returning of as-run logs by the computer terminal 16. The Federal Circuit has recently reiterated that “in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention.” (*In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005), citing *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989)). As set forth above, Kauffman is silent on any functionality of the computer terminal 16 other than to convert received files and play them on a display. There is simply no enablement of any additional functionality that can be construed as returning as-run logs, as a remote player does.

For the reasons set forth, Kauffman’s set-top box 14 is not a remote player, his television 12 is not a remote player and his computer terminal 16 is not a remote player, so Kauffman does not teach this element. Because Kauffman specifically limits the placement of the caching inserter 30 as being, “at the extreme” (¶ [0009]) in the set-top box 14, he teaches away from placing the caching inserter in the display device. Ergo, Kauffman does not suggest functionality that would render the television 12 or computer terminal 16 a remote player. Furthermore, the Examiner does not cite the remaining references to cure this deficiency of Kauffman, and the Applicants do not find any such teaching therein.

Accordingly, the references cited by the Examiner, alone and in combination, fail to teach or suggest a remote player, and the cited combinations fail to teach or suggest each and every element of the claims. Thus, a *prima facie* case of obviousness fails, and the claims are allowable. Therefore, the Applicants respectfully request that the Board reverse the Examiner's Final Rejection of Claims 1-20 under 35 U.S.C. and allow issuance thereof.

II. Conclusion

In view of the foregoing remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-20.

The Commissioner is hereby authorized to charge any fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in dark ink, appearing to read 'DHH', is written over a horizontal line.

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Dated: AUGUST 3, 2006

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